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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,695	11/04/2003	Yoichiro Yamashita	1131-0491P	5835
2292 7590 11/27/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER LAZORCIK, JASON L	
			ART UNIT 1791	PAPER NUMBER
			NOTIFICATION DATE 11/27/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/699,695

**Applicant(s)**

YAMASHITA ET AL.

**Examiner**

Jason L. Lazorcik

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6, 16, 17, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 16-17, and 22-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

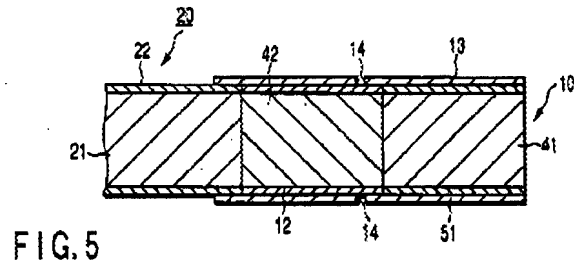
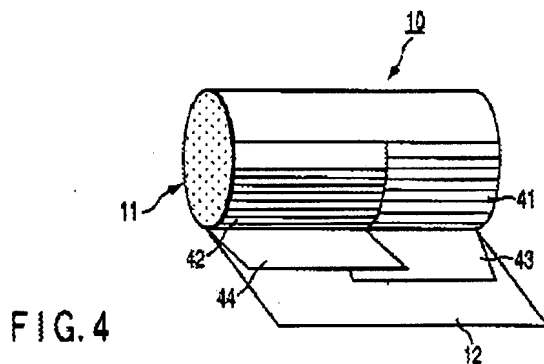
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6, 16-17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneki (US 6,568,402 B1) in view of Aronoff et. al. (US 5,107,866) and Fietkau (US 2002/0023655A1).

Kaneki (US 6,568,402 B1) teaches a filter assembly for a cigarette. With particular respect to the instant reference figure 4, the filter assembly comprises a first plain filter element (41) adjacent to a second charcoal filter element (42). Each of the first and second filter elements are individually wrapped in wrapping papers (43 and 44), a single tipping paper (12) or "forming paper" which extends along the entire length of both the plain and charcoal filter elements is wound around the forming papers (42 and 43).



The instant reference Figure 5, also shows that a similar filter assembly may be joined to a tobacco column by a single tip paper (13) which circumscribes the forming paper (12). Like the forming paper (12), the tipping paper (13) extends the full length of the filter elements (41, 42) and it additionally extends over a portion of the tobacco column to secure the filter thereto.

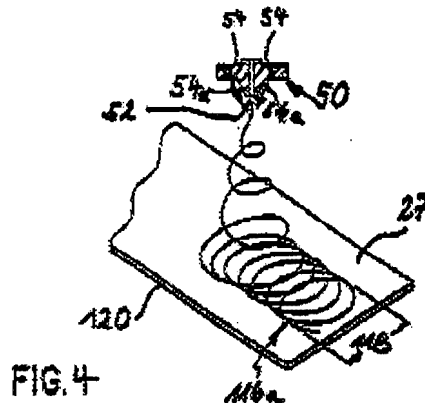
The Kaneki reference does not explicitly depict the use of a tipping paper to secure the filter in figure 4 to a tobacco column. However in view of the Kaneki disclosure, it would have represented a merely trivial extension over the prior art teachings for one of ordinary skill in the art at the time of the invention to secure the figure 4 filter to a cigarette. Specifically, it would have been obvious to utilize a tipping paper (13) as depicted in the Figure 5 cigarette structure to secure the filter assembly depicted in figure 4 to a tobacco column (21).

It is evident from the foregoing that the Kaneki reference either explicitly discloses or renders obvious every element of Applicants claimed filter assembly structure. While there may be no specific discussion of adhesive provided between the

wrapping material and the filter, and between the wrapping material and wrapping paper, it follows that one would have applied said adhesive in such manner as to secure the wrapping to the filter elements in order to secure the elements together, as such is well-known to skilled practitioners in the cigarette arts.

For example, the reference to Arnoff et. al. discloses that the adhesive material can be applied in a spiral manner (corresponding to the claimed "loop pattern") – if desired, or in a banded pattern, see Fig. 3 (corresponding to the claimed "plurality of adhesive-applied parts arranged at intervals in an axial direction of the filter element"). Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to have also applied the same adhesive between the two wrapping materials in order to further secure same to ensure the filter elements will be sufficiently positioned during smoking.

Similarly, the reference to Fietkau (US 2002/0023655A1) teaches a particular method of applying an adhesive layer in a spiral geometry. As evidenced by the following excerpt figure 4, the Fietkau process teaches providing a continuous loop pattern over "surface of the wrapping paper" (27) where adjacent loops in the conveyance direction or "longitudinal direction" are "connected to each other with an overlap". The disclosure further teaches that "the width 118 of the layer can be selected and varied in a simple and reliable manner such as by altering the directions and/or velocities of the jets or flows of air which issue from the ports 54."



Fietkau further teaches that the non-linear application of adhesive to one side of the running web 27 provides "a distribution of adhesive on (the) side is much more satisfactory than the heretofore known (compared to) customary applications of straight wide or narrow strips or bands of adhesive". Specifically, the reference teaches that a particular advantage of the spiral overlapping adhesive application is that such a layer of adhesive is "less likely to penetrate through the web".

Neither Kaneki nor Aronoff references explicitly set forth an application of an adhesive presenting overlapping adjacent loops of adhesive in the longitudinal direction. However, one of ordinary skill in the art who was aware of the Fietkau teachings would have been fully equipped to tailor both the individual adhesive loop width adjacent adhesive loop overlap to achieve the desired bonding strength while minimizing adhesive penetration of the filter wrapper.

### ***Response to Arguments***

Applicant argues that the Kaneki reference teaches two filter embodiments, neither of which adequately discloses the claimed filter element.

Applicant specifically points to the prior art figure 4 filter alleging that said filter discloses only a single wrapper paper (12) disposed about two individual wrapping papers (42 and 43). It is here noted that Applicants argument which states that "wrapping paper 12 is wrapped around two individual wrapping papers 41, 42, and 5" appears to be an inadvertent mischaracterization by Applicant. Specifically, the elements 41 and 42 are clearly set forth in the reference as filter elements and not as wrapping papers and there does not appear an element 5 referenced anywhere in the prior art.

Applicant next points to the prior art embodiment depicted in the reference figure 5. Here Applicant alleges that the instant embodiment disclosed a pair of wrapping papers (12) disposed individually about filter elements 41 and 42 with a single tipping paper 13 wrapped about the wrapping papers (12).

Applicant concludes that none of the filter embodiments disclosed in the prior art teach a filter structure characterized by

- 1) wrapping paper about each of two adjacent filter elements
- 2) a single forming paper disposed about the wrapping papers which extends substantially the entire length of both filter elements, and

3) a tipping paper about the forming paper which likewise extends the entire length of both filter elements

The Examiner finds Applicants arguments unpersuasive.

Specifically as set forth in the rejection of claims above, the instant reference figure 4 explicitly teaches that each filter element (e.g. plain and carbon filled) may be individually wrapped by wrapping papers. The figure further teaches that these individually wrapped filter elements may be joined into a unitary, composite filter by wrapping with a "forming paper" (12).

Now, practitioners skilled in the art of manufacturing cigarettes would certainly recognize that filters of the type depicted in figure 4 are joined to tobacco columns through the use of a "tipping paper". Such a practice would be considered a conventional approach for constructing a filtered cigarette structure. This conventional practice is further supported the cigarette embodiments presented in the instant reference figure 1 and figure 4. Specifically, each of these embodiments depicts the use of a tipping paper (13), which extends the full length of the filter and extending slightly over the tobacco column in order to join the filter to the tobacco column. This tip paper (13) is applied over the forming paper (12), and a similar arrangement would have represented an obvious approach to secure the figure 4 filter to a tobacco column.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL

  
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